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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,715	08/22/2001	Hideaki Takahashi	SON-2200	6288
23353 7590 03/17/2008 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER				
KESACK, DANIEL				
ART UNIT		PAPER NUMBER		
3691				
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03/17/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/933,715

Applicant(s)

TAKAHASHI ET AL.

Examiner

Daniel Kesack

Art Unit

3691

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendments and remarks filed November 13, 2007. Applicant's arguments have been fully considered. Claims 1-7, 9-12, and 15-17 are currently pending. The rejections are as stated below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-7, 9-12, and 15-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel et al., U.S. Patent No. 6,594,640, in view of Chen, U.S. Patent No. 6,549,912, and further in view of Davis, U.S. Patent No. 6,282,522.

Claims 1, 11, Postrel teaches a communications system and method comprising:

a first management apparatus for managing first privilege information generated in accordance with a transaction that is conducted by a user via a network in a virtual world (user conducts e-commerce transactions, information is managed by reward servers – column 5 lines 17-36), and a user identifier that is used for identifying the user in such a manner that the first privilege information and the user identifier are correlated with each other (user's reward accounts with each reward server – column 6 lines 20-43);

a second management apparatus for managing second privilege information that is generated in accordance with a transaction conducted by the user in a real world and used for identifying the user in such a manner that the second privilege information and the user identifier are correlated with each other (trading server – column 8 lines 39-58), and wherein the transaction conducted by the user in the real world includes a settlement processing based on the user identifier and a price (coordinates exchange of consideration, which is an amount of credits in the user's account, or a price, and where the user's account is identified by an account identifier, as described above – column 8 lines 50-54);

wherein the second management apparatus converts the first privilege information that is managed by the first management apparatus into privilege information to be managed by itself (column 8 line 65 – column 9 line 21) according to a prescribed conversion factor (column 9 lines 9-12) and manages the privilege information obtained by the result of the conversion, such that the information is

automatically converted when the user conducts transactions in the virtual world (wherein the user request is considered conducting a transaction in the virtual world).

Postrel fails to teach the identifier is stored in an IC card.

Chen discloses a loyalty file structure for smart cards wherein user identification information relating to a loyalty program is stored on a smart card (figures 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel to include storing identification information on a smart card because the environment in which Chen implements the disclosed invention is identical to the operational environment of Postrel (Postrel discloses the use of the system with a smart card – column 9 lines 55-67), and the smart card identification of Chen provides a convenient way for a card holder to identify himself or herself, and convenience is a desirable feature in the current invention.

Postrel and Chen fail to teach transactions conducted in the virtual world using an IC card.

Davis discloses an internet payment system and method using a smart card, wherein the a user is able to conduct transactions in the virtual world of the internet using an IC card, containing user information (abstract), including reward point programs. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel and Chen to include the

teachings of Davis because Davis teaches the system being used with award points programs over the Internet (column 24 lines 61-67).

Claims 2, 3, 5, 12, 15, Postrel teaches the privilege information is an addable point (column 6 lines 37-40), which describe how much the user is able to redeem, and which is redeemable for service (column 1 lines 13-15).

Claim 4, Postrel teaches the conversion of privilege information taking place in response to a request from the user (column 4 lines 6-11).

Claim 6, Postrel teaches the second management apparatus performing settlement processing in response to a settlement request about a transaction that the user has conducted (column 7 lines 31-41).

Claim 7, Postrel teaches the second management apparatus performs the processing of issuing the point (column 5 lines 11-20).

Claims 9, 16, Postrel teaches the first management apparatus providing the privilege information in accordance with a contribution by the user in the virtual world (user makes a purchase, and points are provided to the user through the reward server – column 5 lines 17-36).

Claims 10, 17, Postrel teaches the second management apparatus providing the privilege information in accordance with a credibility of the user (column 6 lines 1-7).

Response to Arguments

5. Applicant's arguments filed November 13, 2007 have been fully considered but they are not persuasive.

Applicant argues that Examiner has never shown in any Office Action in Postrel, a difference between real world and virtual world transactions. Examiner respectfully disagrees at least because Examiner has provided different citations from the Postrel reference when referring to the claim language related to virtual world transactions, and the claim language related to real world transactions. Examiner further clarified this position in the Office Action dated August 13, 2007 in the response to Applicant's arguments. Therefore, Examiner submits that Postrel teaches both real world and virtual world transaction substantially as claimed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that Examiner has paraphrased Applicant's claims, leaving in elements Examiner believed were found in the prior art, and leaving out those the examiner believed were absent or unimportant. Examiner respectfully disagrees. Examiner submits that the prior art of record teach each and every claim limitation, and Examiner has provided various citations for where elements can be found. While Examiner has not reproduced the language of every claim verbatim in the Office Action, this is due to the fact that, in some cases, the prior art uses different language than the Applicant to describe equivalent elements or features. Therefore, it is sometimes necessary to paraphrase Applicant's claim language in order to present a coherent application of the prior art as it relates to Applicant's claimed invention. This is in no way an admission that the language which is not reproduced verbatim is not taught in the prior art, or is considered "unimportant". Examiner provides the citations and the "paraphrasing" as a guide for how Examiner has applied the prior art, but submits that one of ordinary skill in the art can appreciate how the prior art of reference cover each and every claim limitation.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Kesack whose telephone number is (571)272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted,

Daniel Kesack
March 1, 2008
/D. K./
Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691